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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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LEE, MANN, SMITH, MCWILLIAMS, SWEENEY & OHLSON
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EXAMINER

MAYO III, WILLIAM H

ART UNIT PAPER NUMBER

2831

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,613

Applicant(s)

GAREIS, GALEN M.

Examiner

William H. Mayo III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 5-6 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on December 19, 2003 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of Patent Number 6,297,454 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda et al (JP Pat Num 4-332406, herein referred to as Ikeda). Ikeda discloses spacer type cable (Figs 1-4). Specifically, with respect to claim 1, Ikeda discloses a twisted pair cable separator spline (Fig 1) capable of being used with communication cable (Page 2, line 7) and comprising a longitudinally extending spline (5) having a plurality of spaced longitudinally extending pockets (denoted as 30 & 40), a cross section of the spline (5) having a major axis (left to right, denoted as 20) and a minor axis (top to bottom, denoted as 10) and wherein at least one pocket (40) is on the major

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axis (20) and at least one pocket (30) is on minor axis (10). With respect to claim 2, Ikeda discloses that the major axis (20) is substantially perpendicular to the minor axis (10) and each of the pockets (30 & 40) longitudinally extends substantially parallel to each other (Fig 1). With respect to claim 4, Ikeda discloses that the spline (5) has a first (40), second (60), third (30), and fourth (50) spaced longitudinally extending open pocket (Figs 1), wherein a cross section of the spline (5) has a major axis (20) and a minor axis (10), and wherein the first and second pockets (40 & 60 respectively) have substantially the same cross sectional area (Figs 1) and the third and fourth pockets (30 & 50 respectively) have substantially the same cross sectional area (Fig 1).

However, Ikeda doesn't necessarily disclose the major axis having a length greater than a length of the minor axis (claim 1).

With respect to claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cable separator spline of Ikeda to comprise the major axis to have a longer length than the minor axis wherein the first and second pockets will have a depth greater than the depth of the third and fourth pockets, since Ikeda teaches that the groove shape is not limited to the explained configuration and states that all types of variations in the design are included in the scope of the present invention and since it has been held that more than mere change of form or rearrangement of parts is necessary for patentability. *Span-Deck Inc v Fab-Con, Inc*, (CA 8, 1982) 215 USPQ 835.

Allowable Subject Matter

4. Claims 3 and 5-6 are allowed.
5. The following is an examiner's statement of reasons for allowance: This invention deals with a communication cable separator spline comprising pockets having a cross-sectional area which is 75% or less than a cross-sectional area of a circular envelope of an insulated cable to be placed in the pockets (claims 3 & 5). This invention also deals with a communication cable having a longitudinally extending spline comprising first, second, third, and fourth pockets having a cross-sectional area which is 25% to 75% of the cross-sectional area of a circular envelope of an twisted pair cable in the pockets (claim 6).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

6. Applicant's arguments filed December 19, 2003 have been fully considered but they are not persuasive. The applicant argues the following:
 - A) The prior art must suggest the changes and the reasons that such a spline should be so constructed and Ikeda doesn't suggest what substitutions should be made to arrive at appellant's invention.

- B) Ikeda does not support a teaching of an oval shape or spacer and doesn't recognize or teach the advantages of an oval shape as taught by the applicant.

In response argument A, the examiner respectfully traverses. The examiner recognizes that obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ikeda clearly teaches that the shape of the groove may be modified to comprise all types of variations. Specifically, on page 5, lines 8-14, under the heading "(Other variations)", Ikeda states

"Up to this point, a representative example as shown in Figure 1 with the shape, groove shape, number of grooves, and the like of the spacer (1) has been explained, but it is not limited to this, and equivalent results are obtained even if the cross section is square or polygonal for the spacer shape. That is to say, it goes without saying that all types of variations in the design are included within the scope of the present invention."

Clearly, Ikeda states that "all types of variation in design are included within the scope of the invention". While Ikeda states that the grooves may be square or

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polygonal shaped, certainly Ikeda clearly teaches that the grooves may be any variation or shape and based on this teaching, it would have been obvious to modify the shape of the groove of Ikeda to be of any shape, such as an oval, which would produce the major axis being longer than the minor axis.

7. With respect to argument B, the examiner respectfully traverses. Clearly, as stated above, Ikeda teaches that the groove shapes may have different variations and shapes. While oval shape is not specifically stated, oval shape would certainly lie in the teaching ranges of Ikeda. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Therefore, the examiner respectfully submits that the 35 USC 103 rejection is proper and just.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Communication

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William H. Mayo III
Primary Examiner
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WHM III